

## REMARKS

The Examiner is respectfully thanked for the thoughtful consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 47-54 has been amended solely to correct a typographical error.

Claims 42 and 45-68 are now pending in this application. Claims 42, 45, and 68 are the independent claims.

### I. The Indefiniteness Rejections

Each of claims 47-54 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. These rejections are respectfully traversed.

Each of claims 47-54 has been amended solely to correct a typographical error.

Thus, reconsideration and withdrawal of these rejections is respectfully requested.

### II. The Obviousness Rejections

#### A. Claim Construction

On 12 July 2005, the *en banc* Federal Circuit, in *Phillips v. AWH Corp.*, No. 03-1269 (Fed. Cir. 2005), clarified that:

1. “[t]he Patent and Trademark Office (‘PTO’) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘**in light of the specification as it would be interpreted by one of ordinary skill in the art**’”;
2. the words of a claim “are generally given their ordinary and customary meaning”;
3. the ordinary and customary meaning of a claim term is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the

- invention, i.e., as of the effective filing date of the patent application”;
4. “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but **in the context of the entire patent**, including the specification”;
  5. even “the context in which a term is used in the asserted claim can be highly instructive”;
  6. “the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, **the inventor’s lexicography governs**”;
  7. even “when guidance is not provided in explicit definitional format, **the specification may define claim terms by implication** such that the meaning may be found in or ascertained by a reading of the patent documents”;
  8. an “invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office”; and
  9. the “prosecution history... consists of the complete record of the proceedings before the PTO and **includes the prior art cited** during the examination of the patent.”

In the present Application, the customary meaning for the phrase “domain” is implicitly defined in the specification and the cited art. That definition must control examination of those claims that recite this phrase.

At least at page 8, the specification of the present Application implicitly defines the term “domain” by stating that: [a]llias addresses are unique within a Zone, Domain, among Zones, and among Domains.

U.S. Patent Number 6,732,177 (Roy), a related patent of the inventor and the assignee of the present Application, and having the same filing date as the present application but with an earlier priority date, is cited as prior art to the present Application in an Information Disclosure Statement filed herewith. Roy provides context for determining a proper meaning for the phrase

“domain” by stating, “zone and (administrative) domain have been defined in accordance to ITU-T Recommendations H.323 and H.225.0. The abstraction of zone is such that it is managed by a gatekeeper while **a domain consists of one or more zones.**” See col. 2, lines 37-41.

ITU-T Recommendation H.323 defines a zone as a “collection of all terminals (Tx), Gateways (GW), and Multipoint Control Units (MCUs) managed by a single Gatekeeper (GK). A Zone includes at least one terminal, and may or may not include Gateways or MCUs. A Zone has one and only one Gatekeeper. A Zone may be independent of network topology and may be comprised of multiple network segments which are connected using routes (R) or other devices.” See section 3.49.

ITU-T Recommendation H.323 defines a domain as a “collection of H.323 entities administered by one administrative entity. An administrative domain can consist of one or more gatekeepers (that is, one or more zones).” See Annex G, definition G.2.1.

## **B. Standard**

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” See MPEP 2143. Moreover, the USPTO “has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

It is respectfully noted that because the Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference

will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection cannot properly be made final. *See In re Wiechert*, 152 U.S.P.Q. 247, 251-52 (C.C.P.A. 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

### C. Claim 42

Claim 42 was rejected under 35 U.S.C. 103(a) as being unpatentable over Bennefeld (U.S. Patent No. 6,519,249). This rejection is respectfully traversed.

To the extent that official notice is taken to support the rejection, the rejection is respectfully traversed and citation and provision of a reference that supports the rejection is respectfully requested. *See* MPEP 2144.03. Specifically, Applicant respectfully traverses the apparent official notice taken by the statement “[a]lthough Bennefeld does not teach a ‘non-gatekeeper database,’ the function of the ‘non-gatekeeper database’ in applicant’s invention and the database of the gatekeeper in Bennefeld are the same; i.e. they both are used to store/retrieve translation information for alias addresses and further routing information of mobile entities in the network. It would have been obvious to one of ordinary skill in the art at the time of invention to use the database inside the gatekeeper of Bennefeld for the database outside of a gatekeeper (or not in a gatekeeper at all) of applicant’s invention because the placement of the database in one location provides no unexpected advantage over the placement of the database in another location, thus they are obvious expedients of one another.” *See* Page 3 - Page 4. Applicant respectfully requests a reference that supports those statements.

Independent claim 42 recites a “**non-gatekeeper database** external to a domain of a calling entity and external to a donor domain of the H.323 entity”. Bennefeld does not expressly or inherently teach or suggest a “non-gatekeeper database external to a domain of a calling entity and external to a donor domain of the H.323 entity”.

Instead, Bennefeld allegedly recites a “plurality of Gatekeeper service nodes and a plurality of **Gatekeeper Database** nodes”. *See* Abstract.

Further, Bennefeld allegedly illustrates a “root gatekeeper” that is external to a plurality of “**zones**”. *See* Fig. 5B. Thus Bennefeld’s “root gatekeeper” is not expressly or inherently “external to a **domain** of a calling entity and external to a donor **domain** of the H.323 entity”.

Thus, even if there were motivation or suggestion to modify or combine the applied references (an assumption that is respectfully traversed), even if there were a reasonable expectation of success in combining or modify the applied references (another assumption that is respectfully traversed), and even if the teaching or suggestion to make the claimed combination and the reasonable expectation of success were both found in the prior art (another assumption that is respectfully traversed), the applied references still do not expressly or inherently teach or suggest every limitation of claim 42, and consequently fail to establish a *prima facie* case of obviousness.

Consequently, reconsideration and withdrawal of this rejection is respectfully requested.

#### **D. Claims 45-47, 49-52, 55, 62, 63, and 68**

Each of claims 45-47, 49-52, 55, 62, 63, and 68 was rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson (U.S. Patent No. 6,693,894). These rejections are respectfully traversed.

To the extent that official notice is taken to support the rejection, the rejection is respectfully traversed and citation and provision of a reference that supports the rejection is respectfully requested. *See* MPEP 2144.03.

Specifically, Applicant respectfully traverses the apparent official notice taken by the statement “[a]lthough Andersson does not teach a ‘non-gatekeeper database,’ the function of the ‘non-gatekeeper database’ in applicant’s invention and the database of the gatekeeper in Andersson are the same; i.e. they both are used to store/retrieve translation information for alias addresses and further routing information of mobile entities in the network. It would have been obvious to one of ordinary skill in the art at the time of invention to use the database inside the gatekeeper of Andersson for the database outside of a gatekeeper (or not in a gatekeeper at all) of applicant’s invention because the placement of the database in one location provides no unexpected advantage over the placement of the database in another location, thus they are obvious expedients of one another.” *See* Page 5 - Page 6. Applicant respectfully requests a reference that supports those statements.

Applicant also traverses the apparent official notice taken in the statement that “Andersson however, does not teach that the gatekeeper memory is a ‘cache’ memory. It would have been obvious to one of ordinary skill in the art at the time of invention to include use a cache memory in the gatekeeper as a matter of design choice.” *See* Page 8. Applicant respectfully requests a reference that supports that statement.

Each of independent claims 45 and 68 recites a “**non-gatekeeper database** external to the first domain, the second domain, and the third domain”. Andersson does not expressly or inherently teach or suggest a “non-gatekeeper database external to the first domain, the second domain, and the third domain”.

Instead, Andersson allegedly recites a “**gatekeeper** 322 of the IP network 308 is used to obtain routing information indicating the current location of the roaming called mobile party”. *See* col. 3, lines 37-40.

Further, Andersson allegedly illustrates a “gatekeeper” that is external to a plurality of “**mobile networks**”. *See* Fig. 3. Thus Andersson’s “gatekeeper” is not expressly or inherently “external to the first **domain**, the second **domain**, and the third **domain**”.

Thus, even if there were motivation or suggestion to modify or combine the applied references (an assumption that is respectfully traversed), even if there were a reasonable expectation of success in combining or modify the applied references (another assumption that is respectfully traversed), and even if the teaching or suggestion to make the claimed combination and the reasonable expectation of success were both found in the prior art (another assumption that is respectfully traversed), the applied references still do not expressly or inherently teach or suggest every limitation of claims 45 and 68, and consequently fail to establish a *prima facie* case of obviousness.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

Consequently, reconsideration and withdrawal of this rejection is respectfully requested.

**E. Claims 48, 53, 54, 56-61, and 64-67**

Each of claims 48, 53, 54, 56-61, and 64-67 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of Andersson (U.S. Patent No. 6,693,894), Wiryaman (U.S. Patent No. 6,157,401), Lu (U.S. Patent No. 6,100,918), Jain ("Mobile Internet Access & QoS Guarantees Using Mobile IP and RSVP with Location Registers"), Tiedemann (U.S. Patent No. 5,862,471), and/or Chau (U.S. Patent No. 5,764,750). These rejections are respectfully traversed.

Each of claims 48, 53, 54, 56-61, and 64-67 is dependent on independent claim 45. As stated above, Anderson fails to establish a *prima facie* case of obviousness for claim 45. None of the other cited references overcome the deficiencies of Andersson.

Thus, even if there were motivation or suggestion to modify or combine the applied references (an assumption that is respectfully traversed), even if there were a reasonable expectation of success in combining or modify the applied references (another assumption that is

respectfully traversed), and even if the teaching or suggestion to make the claimed combination and the reasonable expectation of success were both found in the prior art (another assumption that is respectfully traversed), the applied references still do not expressly or inherently teach or suggest every limitation of claim 45, and consequently fail to establish a *prima facie* case of obviousness.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

### III. Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

“none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely,

claim 42 is allowable because none of the references of record alone or in combination disclose or suggest ‘receiving, at a wide area network-based intelligent service controller, a request to originate a call to an H.323 entity, the request comprising an alias address associated with the H.323 entity, the wide area network-based intelligent service controller comprising a non-gatekeeper database external to a domain of a calling entity and external to a donor domain of the H.323 entity’; and

claims 45-68 are allowable because none of the references of record alone or in combination disclose or suggest ‘receiving a called routable alias address for the called H.323 entity, the called routable alias address associated with the alias address of the called H.323 entity, the called routable alias address received from a non-gatekeeper database external to the first domain, the second domain, and the third domain’”.



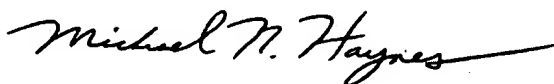
**CONCLUSION**

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC

A handwritten signature in cursive script that reads "Michael N. Haynes". The signature is written in dark ink and includes a long, sweeping horizontal line at the end.

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